



Correspondence and Mail
BOX AF

RESPONSE UNDER 37 C.F.R. § 1.116
EXPEDITED PROCEDURE REQUESTED
EXAMINING GROUP 2672

AF
2600
#38

PATENT
Customer No. 22,852
Attorney Docket No. 05905.0056

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
)
Maki KATO et al.) Group Art Unit: 2672
)
Application No.: 09/135,024) Examiner: GOOD-JOHNSON, Motilewa
)
Filed: August 17, 1998)
)
For: DATA PROCESSING)
APPARATUS AND PROCESSING)
METHOD AND MEDIUM FOR)
ELECTRONIC GAMES)

RECEIVED

MAY 26 2004

Technology Center 2600

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

REQUEST FOR RECONSIDERATION

In reply to the Final Office Action mailed February 26, 2004, the period for response extending to May 26, 2004, and pursuant to 37 C.F.R. § 1.116, Applicants respectfully request reconsideration in light of the following remarks.

Claims 17-21, 24, 25, and 28 remain pending in this application. In the Final Office Action, the Examiner rejected claims 17-21, 24, 25, and 28 under 35 U.S.C. § 103(a) as unpatentable over Ishikawa et al. (U.S. Patent No. 6,317,130) in view of Rayman, UBISOFT Corporation, release 1994. Applicants respectfully traverse the rejection.

To establish a proper *prima facie* case of obviousness under 35 U.S.C. § 103(a), the Examiner must demonstrate each of three requirements. First, the reference or references, taken alone or combined, must teach or suggest each and every element recited in the claims. See M.P.E.P. § 2143.03 (8th ed. 2001). Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention. See M.P.E.P. § 2143.01 (8th ed. 2001). Third, a reasonable expectation of success must exist. See M.P.E.P. § 2143.02 (8th ed. 2001). Moreover, each of these requirements must be found in the prior art, not in applicant's disclosure. See M.P.E.P. § 2143 (8th ed. 2001).

Applicants' claim 17 recites a data processing apparatus for positioning a game character on a display comprising, among other things, "a game character model, including a reference polygon and component polygons that are separated from the reference polygon, wherein no other polygons are included between said reference polygon and said component polygons." Ishikawa and Rayman, taken alone or in combination, do not disclose or suggest at least these features.

Ishikawa discloses using a skeletal structure to define a character's form, including polygons that are joined together to form the character. See col. 2, lines 53-58. In making the rejection, the Examiner admits Ishikawa "fails to disclose a game character model, including a reference polygon and component polygons, that are separated from the reference polygon, wherein no other polygons are included between said reference polygon and said component polygons" (Office Action, page 3). The

Examiner then alleges Rayman makes up for the deficiencies of Ishikawa. Applicants respectfully disagree.

Applicants respectfully submit that Rayman is not a competent prior art reference. Rayman merely includes screenshots depicting a game character. The reference does not include any form of description that would enable one of skill in the art to determine how to design or implement a game character as shown in the screenshots. A prior art reference must be enabling just as a U.S. patent must be enabling under 35 U.S.C. § 112, first paragraph. See *Paperless Accounting, Inc. v. Bay Area Rapid Transit Sys.*, 804 F.2d 659, 665, 231 U.S.P.Q. 649, 653 (Fed. Cir. 1986), *cert. denied*, 480 U.S. 933 (1987); *In re Moreton*, 288 F.2d 708, 711, 129 U.S.P.Q. 227, 230 (C.C.P.A. 1961). Rayman, however, does not teach one of skill in the art how the game character was created.

Additionally, portions of the documents supplied by the Examiner do not qualify as prior art. In particular, according to the "Moby Games" page of the reference (page 7), Ubisoft Corporation developed and published an apparently three-dimensional sequel to "Rayman." However, the sequel, titled "Rayman 2: The Great Escape," was published as early as 1999, according to the chart entitled "Rayman Series." However, the present application was filed August 17, 1998. Accordingly, this portion of the reference does not constitute prior art.

Even if Rayman were a competent prior art reference, which Applicants dispute, Rayman does not disclose or suggest at least "a game character model, including a reference polygon and component polygons that are separated from the reference polygon, wherein no other polygons are included between said reference polygon and

said component polygons,” as recited in claim 17 (emphasis added). In making the rejection, the Examiner cites Ubisoft Corporation’s 1994 release of the “Rayman” game. Applicants believe the Examiner is in fact referring to the 1995 release as that is the first release of the game listed in the document. Should Applicants’ understanding be incorrect, Applicants request the Examiner to so clarify in the next Office communication.

In the materials enclosed with the Rayman reference, the page entitled “Moby Games” (page 7) lists the various incarnations of the Rayman character and different game releases. According to the document, the first release of the game, entitled “Rayman,” occurred in 1995. However, this release, which was cited by the Examiner, provides a two-dimensional game in which a character is depicted by two-dimensional graphics. The 1995 release of “Rayman,” therefore, does not disclose or suggest at least “a game character model, including a reference polygon and component polygons that are separated from the reference polygon, wherein no other polygons are included between said reference polygon and said component polygons,” as recited in claim 17 (emphasis added). As indicated earlier, there is no teaching in the Rayman document of how the character was designed or implemented. Accordingly, the cited prior art references of Ishikawa and Rayman, whether taken alone or in combination, do not disclose or suggest claim 17.

In addition, there is no motivation or suggestion to combine Ishikawa with Rayman. Ishikawa discloses generating a skeletal structure to define a character’s form using polygons to form the character. See col. 2, lines 53-58. As discussed above, however, Rayman only discloses a two-dimensional character. Accordingly, one of skill

in the art would not be motivated to combine Ishikawa's three-dimensional teachings with that of the two-dimensional character found in Rayman.

For at least the above reasons, the Examiner has not demonstrated that all of the features of claim 17 are disclosed or suggested by the cited prior art. Claim 19 includes recitations of a scope similar to claim 17. Accordingly, Applicants respectfully request the Examiner to withdraw the rejection of independent claims 17 and 19.

Each of dependent claims 18, 20, 21, 24, 25, and 28 depend from allowable claims 17 and 19 and are at least allowable due to their dependency upon their allowable base claims. Accordingly, Applicants respectfully request the Examiner to also withdraw the rejection of dependent claims 18, 20, 21, 24, 25, and 28.